



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,669	10/23/2003	Matthew Lerner	003797.00675	5871
28319 7590 05/07/2008 BANNER & WITCOFF, LTD. ATTORNEYS FOR CLIENT NOS. 003797 & 013797 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051				
EXAMINER				
RUTLEDGE, AMELIA L.				
ART UNIT		PAPER NUMBER		
2176				
MAIL DATE		DELIVERY MODE		
05/07/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/690,669

Applicant(s)

LERNER ET AL.

Examiner

AMELIA RUTLEDGE

Art Unit

2176

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 8, 11-13, 21, 24, 26, 27, 35, 38 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 8, 11-13, 21, 24, 26, 27, 35, 38 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Amendment, filed 12/05/2007.
2. Claims 1, 8, 11-13, 21, 24, 26, 27, 35, 38 and 40 are pending in the case.

Claims 1, 13, and 27 are independent claims.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 8, 11-13, 21, 24, 26, 27, 35, 38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moran, U.S. Patent No. 6,509,912, issued January 2003, in view of Saund, U.S. Patent No. 6,411,732 B1, issued June 2002.**

Regarding independent claim 1, Moran teaches domain objects, programmatically equivalent to the claimed property values, which are context specific representations of information that are used in a freeform graphics system (Abstract, Figs. 22 and 26, col. 2, l. 28-57; col. 13, l. 13-col. 14, l. 23; claim 1), and that domain objects are represented in the system by a graphic object, i.e., icon, representing an instance of the domain object.

Moran teaches a storage, access, and rendering system for the domain objects (col. 6, l. 20-col. 7, l. 25), compare to claim 1, *a storage system that stores the property value of the document or file in electronic ink format; and an ink access system that*

allows the operating system to access the stored property value in electronic ink format, wherein the rendering system renders the stored property value in electronic ink format as part of a file preview operation.

Moran teaches that the property value in electronic ink format includes an electronic ink title for the document or file (col. 13, l. 13-col. 14, l. 23; especially col. 14, l. 5-6; col. 21, l. 52-60), and that the title may be rendered as part of a file list operation (col. 10, l. 60-col. 11, l. 31). Moran teaches that the title may be rendered as part of a file preview operation (col. 13, l. 20-29), since Moran discloses that the user may expand the information about a domain object by double tapping on the icon, this will result in another layout of the domain object being displayed as an overlay, i.e., file preview. Moran teaches assigning a title to the document, equivalent to a document filename, rendered in electronic ink (col. 13, l. 13-col. 14, l. 23; especially col. 14, l. 5-6; col. 21, l. 52-60), compare to *wherein the property value in electronic ink format includes an electronic ink filename for the document or file.*

Moran teaches that the system receives a property value of a document or file on the system in electronic ink format (col. 21, l. 25-51; col. 22, l. 8-23). Moran teaches that the property value is received as part of a file or document save operation because Moran teaches that system operations can be associated with user actions and the class definition of a domain object (col. 9, l. 50-col. 10, l. 10), therefore Moran suggests that the domain objects, i.e., property values may be received as part of a file or document save operation. While Moran does not explicitly teach *a rendering system for rendering a file save interface in response to the input system receiving the file save*

command, the input system configured to receive in electronic ink format a property value of a document or file on or accessible by the computer system in the file save interface; Saund teaches an electronic ink interface board for rendering a file save interface, the input system configured to receive in electronic ink format a property value of a document or file on or accessible by the computer system in the file save interface, because Saund teaches that the electronic ink board allows a user to draw interface elements representing save actions (Fig. 31, 33) and performing file save commands for electronic ink property values in the save interface (col. 6, l. 45-col. 7, l. 64). For example, Saund teaches rendering an electronic ink file save interface and saving an image file or text (col. 7, l. 5-38).

Both Moran and Saund are directed toward computer systems having electronic ink interfaces. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the user drawn electronic ink interface elements and tokens disclosed by Saund with the freeform graphics system and domain objects disclosed by Moran, in order to allow the user of a whiteboard interface greater ability to specify operations to be executed, and when they could be executed, in order to store data created on the electronic ink interface as a file (Saund, col. 1, l. 23-col. 2, l. 21; col. 4, l. 21-29).

Regarding dependent claim 8, Moran teaches that the input system is activated in response to a command from an application program requesting activation of electronic ink input with respect to at least one document or file in the application program, since Moran teaches that the freeform editing program requests activation of

electronic ink input with respect to documents or files in the program (col. 6, l. 20-col. 7, l. 25).

Regarding dependent claims 11 and 12, Moran teaches that the input system receives from a user a change to the property value in electronic ink format associated with the document or file (col. 13, l. 13-col. 14, l. 23; claim 1), and that the property value in electronic ink format includes an electronic ink title (col. 13, l. 13-col. 14, l. 23; especially col. 14, l. 5-6; col. 21, l. 52-60).

Regarding independent claim 13, claim 13 reflects the methods implemented by the system as claimed in claim 1, and is rejected along the same rationale.

Regarding dependent claim 21, 24, and 26, claims 21, 24, and 26 reflect the methods implemented by the system as claimed in claims 8, 11, and 12, respectively, and are rejected along the same rationale.

Regarding independent claim 27, claim 27 reflects the computer-readable medium including computer-executable instructions used by the system as claimed in claims 1, 8, and 9, and is rejected along the same rationale.

Regarding dependent claims 35, 38, and 40, claims 35, 38, and 40 reflect the computer-readable medium including computer-executable instructions implemented by the system claimed in claims 8, 11, and 12, respectively, and are rejected along the same rationale.

Response to Arguments

2. Applicant's arguments with respect to amended claims 1, 13, and 27 have been considered but are moot in view of the new ground(s) of rejection.
3. The new ground of rejection includes the Saund patent, which is being relied upon to disclose the newly claimed limitations: ...a rendering system for rendering a file save interface in response to the input system receiving the file save command, the input system configured to receive in electronic ink format a property value of a document or file on or accessible by the computer system in the file save interface (Claim 1).

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMELIA RUTLEDGE whose telephone number is (571)272-7508. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR

/William L. Bashore/
William L. Bashore
Primary Examiner
Tech Center 2100